



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,736	08/14/2001	Olivier Schueller	2002907-0002	9022

24280 7590 04/22/2003

Choate, Hall & Stewart
Exchange Place
53 State Street
Boston, MA 02109

EXAMINER

NAFF, DAVID M

ART UNIT	PAPER NUMBER
----------	--------------

1651

DATE MAILED: 04/22/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/929736

Applicant(s)

Schueller et al

Examiner

Naff

Group Art Unit

1657

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 1/28/03
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-38 + 71-85 is/are pending in the application.
- ☐ Of the above claim(s) 71-85 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-38 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4 + 9 (filed 6/10/02 + 3/10/03)
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

In a response of 1/28/03 to a restriction requirement of 11/22/02, applicants elected Group I claims 1-38 without traverse.

Claims 71-85 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 8 of 1/28/03.

Claims examined on the merits are 1-38.

Specification

The disclosure is objected to because of the following informalities: at page 9, line 28, "Figure 1 depicts" should be replaced with -- Figures 1A-1F depict -- to be consistent with the drawing and the specification at page 17, lines 15-26. At page 10, line 6, "Figure 5 depicts" should be replaced with -- Figures 5A-5D depict --, and, line 9, "Figure 8 depicts" should be replaced with -- Figures 8A-8D depict -- to be consistent with the drawing and the specification in the paragraph bridging pages 17 and 18, and at page 20, lines 15-20. At page 4, line 4, it appears "of", second occurrence, should be -- from --. Is the patent number at page 28, line 6, correct?

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6, 7, 9, 10, 30, 31, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Maracas et al (5,669,303).

The claims are drawn to a method of patterning a surface by
5 providing a stamp having a stamping surface, disposing a substrate proximate to the stamping surface and modulating the dimensions of the stamp to place the stamping surface in contact with the substrate.

Maracas et al disclose stamping a surface with a flexible stamp by using pressure to cause the flexible stamp to change shape and contact a
10 surface to be stamp.

Changing the shape of the flexible stamp of Maracas et al modulates dimensions of the stamp, and the method of Maracas et al is the same as presently claimed.

Claim Rejections - 35 USC § 103

15 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

20 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25 This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to
30 point out the inventor and invention dates of each claim that was not

commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 5, 8, 11-29, 32-36 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maracas et al in view of Biebuyck et al (5,925,259), Hidber et al (6,060,121), Everhart (6,020,047) and Jackman et al (1997).

Biebuyck et al, Hidber et al, Everhart and Jackman et al disclose different stamping procedures using different conditions.

10 The claimed conditions of the present dependent claims would have been obvious from stamping procedures disclosed by Biebuyck et al, Hidber et al, Everhart and Jackman et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Naff whose telephone number is (703) 308-0520. The examiner can normally be reached on Monday-Thursday and every other Friday from about 8:30 AM to about 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, a message can be left on voice mail.


20 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn, can be reached at telephone number (703) 308-4743.

The fax phone number is (703) 872-9306 before final rejection or (703) 872-9307 after final rejection.

Application Number: 09/929,736
Art Unit: 1651

Page 5

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.


DAVID M. NAFF
PRIMARY EXAMINER
ART UNIT 1651

DMN
4/21/03